

REMARKS

Claims 11, 16-19 and 21-32 remain pending in this application and are rejected. Claim 21 is cancelled herein. Claims 11, 27, and 32 are amended herein to overcome the 35 U.S.C. §112 1st and 2nd paragraph rejections for new matter and indefiniteness. New claims 33-37 have been added to further distinguish the present invention from the cited art.

New claim 37 has been added to retain recitation of the structural limitation that the first pattern is on the *entire* top surface of said backing layer. The applicants respectfully traverse the Examiner's 35 U.S.C. §112 1st paragraph rejection. The Federal Circuit has stated that "[t]he disclosure as originally filed does not .. have to provide *in haec verba* support for the claimed subject matter at issue." *See Cordis Corp. V. Medtronic AVE Inc.*, 67 USPQ2d 1876, 1885 (Fed Cir. 2003). In other words, "[a]n applicant is not required to describe in the specification every conceivable and possible future embodiment of his invention." *Id. quoting Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 [60 USPQ2d 1851] (Fed. Cir. 2001). Thus, even if, *arguendo*, the original language of the specification does not particularly single out coating the entire surface the specification still provides sufficient support for such an embodiment. Therefore,

the structural limitation that the first pattern is on the entire top surface of the backing layer is not new matter.

The Examiner has maintained the rejections against claims 11, 16-19, 21-22 and 31-32 as being unpatentable over Marchal (U.K. Pat. App. GB 2 063 710) and claims 29-30 as being unpatentable over Marchal as modified by Su (U.S. Pat. No. 5,462,782). More specifically, in regard to claims 11, 16-19, 21-22 and 31-32, the Office Action states that Marchal teaches all the elements recited in the claims except for the width of the self-adhesive sheet being a minimum of 350 mm, thread spacing of 3 to 30 mm and an adhesive strength of the second layer between 0.8 to 5 N, which would have been obvious based upon optimization through routine experimentation and the second textile structure which would have been obvious as mere duplication of essential working parts. In regard to claims 29-30, the Office Action states that Marchal teaches all the elements recited in the claims except for the backing layer being polyethylene which is disclosed in Su and the floor covering being parquet would have been obvious to one skilled in the art. In other words, the rejection characterizes the structure recited in the claims as simply the combining of prior art elements according to known methods to yield predictable results.

The Supreme Court has held that “teaching away” is an indication of nonobviousness. *See U.S. v. Adams*, 383 U.S. 39. In order to establish a prima facie case of obviousness, it is necessary to show that all the claim limitations are taught or suggested by the prior art. *See In re Royka and Martin*, 180 USPQ 580, 583, 490 F.2d 981 (CCPA 1974). MPEP §2143 states that when rejecting a claim based on the rationale that the recited structure is simply “combining prior art elements according to known methods to yield predictable results” there must be a “finding that the prior art included each element.” In addition, there must be a finding that “each element merely performs the same function as it does separately.” Furthermore, “if [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” See MPEP §2143.01 citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). The applicants respectfully traverse the rejections because the prior art fails to include each element as recited in the claims, teaches away from such a modification and such a modification would render the cited art unsatisfactory for its intended purpose.

In regard to claims 11, 27 and 32, Marchal does not disclose first and second adhesive coatings with the same pattern. If a first and a second adhesive coating on a self-adhesive sheet have the same pattern then they must have the

same surface area. However, Marchal states specifically that “[o]ne side of the sheet 11 should always have a larger surface area of adhesive than the other side.” Thus, Marchal teaches away from first and second adhesive coatings with the same pattern. Furthermore, in the previous Office Action of November 9, 2006, the Examiner states on pages 3 and 6 that the Marchal adhesive tape has a “*different* adhesive pattern provided on the top surface and the bottom surface would [to] provide for different adhesive strengths” (emphasis added). Such a distinction is also made by the Examiner on page 8 of the previous Office Action. Thus, modifying Marchal to have the same pattern for both the first and second adhesive coatings would make Marchal unsatisfactory for its intended purpose because the adhesive strengths would be the same on both the top and bottom surface. Therefore, a *prima facie* case of obviousness has not been established because Marchal does not disclose but teaches away from first and second adhesive coatings with the same pattern and modifying Marchal, as recited in the claims, would render it unsatisfactory for its intended purpose. In order to further clarify this distinction of the present invention over the prior art, new claims 33-35 have been added which specifically recite the equivalence of the first and second adhesive coating surface areas.

The applicant respectfully traverses the rejection of claims 17, 19 and 24 wherein no weight was given to the recited process conditions. MPEP §2113 states that “[t]he structure implied by the process steps should be considered when assessing the patentability of product-by-process claims over the prior art, especially where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product.” Applicant has stated in the specification that “[i]n one preferred embodiment of the invention, the different pressure-sensitive adhesive coating and/or the different adhesive strength or adhesive force of the two surfaces is brought about by means of different adhesive application rates.” *See* Substitute Specification page 6. Thus, the product is only defined by the process steps and imparts distinctive structural characteristics in the differing adhesive strengths of the two surfaces. Therefore, the Examiner should consider the process conditions when assessing the patentability of claims 17, 19 and 24 or otherwise allow the claims.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

Applicants request a three month extension of time for responding to the Office Action. The fee of \$525 for the extension is provided for in the charge authorization presented in the PTO-2038, Credit Card Payment form, provided herewith.

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One independent claim in excess of three is added. Accordingly, please charge the fee of \$105 to Deposit Account No. 10-1250.

Respectfully submitted,
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